

REMARKS

The present application has been amended in response to the Examiner's Office Action to place the application in condition for allowance. Applicant, by the amendments presented above, has made a concerted effort to present claims which clearly define over the prior art of record, and thus to place this case in condition for allowance.

In the Office Action, the Examiner indicated that there is insufficient antecedent basis for the limitation "relevant include files and calculation files" in claims 1, 10, 11, 16 and 20. Accordingly, each of said claims has been amended to no longer include said limitation. It is therefore requested that the Examiner's objection be withdrawn.

In addition, the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Publication No. US 2002/0100034 A1 (Croix) in view of United States Patent No. 6,484,149 (Jammes et al.) and further in view of United States Patent No. 6,766,506 (Ratzlaff et al.). Applicant respectfully traverses.

Claim 1, for example, specifically claims a server which is configured to receive a request for an OLA and DPCM and actually produce not only the OLA, but also the DPCM in response to the request. The server physically creates and compiles a DCI memory module based on the request. Applicant respectfully submits that none of the three references cited by the Examiner disclose this.

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For example, the Croix reference at no point in time even references memory templates and memory panlibs or any data structure similar in scope that enables the creation of the OLA (DPCM) memory output. In the present invention, the memory templates are specific to a memory configuration that the user requires and this is different from the information being requested in the Croix reference. In the Croix reference, method and means of obtaining specific path delay and/or capacitive loading information is discussed. In contrast, the present invention is directed at actually generating the DPCM that contains such information for a specific memory type/configuration.

Not only does the Croix reference not disclose or suggest the present invention, but Applicant respectfully submits that a combination of the three references cited by the Examiner does not provide the present invention. Still further, Applicant respectfully submits that the manner in which the Examiner combines the three references in an attempt to arrive at the present invention amounts to hindsight. There are many court decisions which hold that using hindsight is improper. As early as 1891, the United States Supreme Court held that:

Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as further evidence, even as demonstration . . . Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor . . . It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved.

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Diamond Rubber Co. v. Consolidated Rubber Tile Co., 220 U.S. 428 , 435-36.

Applicant further submits that there is no motivation in the prior art to combine the references as asserted by the Examiner. As the Federal Circuit stated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In the present case, the prior art did not suggest the desirability of the modification of Croix asserted by the Examiner. Furthermore, there cannot be said to be a suggestion to combine references where the only source of the suggestion comes from the present application. As stated by the Federal Circuit in ACS Hospital Sys., Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (1984):

The Court below identified no source, other than the Sonnenberg patent itself, for the suggestion to use override switching means in a television rental system. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

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Furthermore, a general relationship between the fields of the prior art references to be combined is insufficient to suggest the motivation. See Interactive Techs. Inc. v. Pittway Corp., Civ. App. No. 98-1464, slip op. At 13 (Fed Cir. June 1, 1999), cert. denied, 528 U.S. 1045 (1999) wherein the Court said, "The sole evidence proffered of a motivation to combine was that several prior art patents mentioned there being a similarity between garage door openers and home security systems. However, such limited evidence of there being a general relationship between the fields does not suggest a motivation to combine the particular references here relied upon."

Even when changes from the prior art are "minor" or "simple", an inquiry must be made as to whether "the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes." Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (quoting Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990)). Applicant respectfully submits that there is no suggestion to combine the references as asserted by the Examiner.

Finally, In In re Ratti, 270 F.2d 810, 123 USPQ 349, 123 USPQ 352 (C.C.P.A. 1957) the Federal Court stated:

We hold...that the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate.

Applicant respectfully submits that to modify the Croix reference as identified by the Examiner would amount to a substantial reconstruction or redesign.


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In view of the above amendments and remarks, Applicant respectfully submits that the claims of the application are allowable over the rejections of the Examiner. Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

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